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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,116	11/03/2000	Toshio Narushima	450100-02829	7791

20999 7590 03/24/2004
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EXAMINER

DESIR, JEAN WICEL

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/24/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,116

Applicant(s)

NARUSHIMA ET AL.

Examiner

Jean W. Désir

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/26/04, entered by RCE filed on 3/12/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-20, 23-36 and 39-47 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 21, 22, 37, 38, 48 and 49 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 6-9, 12, 13, 17-20, 23-29, 30, 34-36, 39, 40, 44-47 rejected under 35 U.S.C. 102(e) as being anticipated by Garland (US 6,366,359).

Claim 1:

Garland discloses in Fig. 2:

“said receiver (items 202, 212, 214), said display (item 208) and said printer (item 216) being connected to each other by way of a first signal transmission means for transmitting digital signals”;

said receiver having :

“a reception means for receiving digital broadcasting (inherent to the system)”;

“an imaging means (items 212, 214) for generating video data by performing a predetermined imaging operation according to the received signals of digital broadcasting”;

“and an output means (outputs of item 214) for transmitting the video data generated by said imaging means by way of said first signal transmission means to said display (208) and to said printer (216)”;

said printer having:

“a reception means for receiving video data transmitted by said first signal transmission means; and a printing means for printing the images of the video data received by said reception means” (item 216).

Claim 2 is disclosed, see Fig. 2 items 212, 214.

Claims 6, 7 are disclosed, see Fig. 2 items 214, 208, 216.

Claims 8, 9 are disclosed, see Fig. 2 item 206.

Claim 12 is rejected for the same reasons as claim 1.

Claims 13, 17-20 are rejected for the same reasons as claims 2, 6-9.

Claim 23:

Garland discloses in Fig. 2:

“a reception means for receiving digital broadcasting (inherent to the system)”;

“an imaging means (items 202, 212, 214) for generating video data by performing a predetermined imaging operation according to the received signals of digital broadcasting”;

“and an output means (outputs of item 214) for transmitting the video data generated by said imaging means to a display (item 208) by way of said first signal transmission means for displaying digital broadcasting and a printer (item 216) for

printing images contained in digital broadcasting by way of a first signal transmission means”.

Claim 24 is disclosed, see Fig. 2 items 212, 214.

Claims 25, 26 are disclosed, see Fig. 2 items 214, 208, 216.

Claims 27, 28 are disclosed, see Fig. 2 item 206.

Claim 29 is disclosed, see Fig. 2 items 210, 206.

Claim 30:

Garland discloses in Fig. 2:

“a reception means (items 212, 214) for receiving the video data transmitted from said receiver to a display (item 208) by way of a first signal transmission means for transmitting signals for displaying digital broadcasting and to the printer (216) by way of said first signal transmission means”;

“and a printing means (item 216) for printing the images of the video data received by said reception means”.

Claim 34 is disclosed, see Fig. 2 items 214, 208, 216.

Claims 35, 36 are disclosed, see Fig. 2 items 206, 210.

Claim 39 is rejected for the same reasons as claim 1.

Claims 40, 44-47 are rejected for the same reasons as claims 2, 6-9.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5, 14-16, 31-33, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garland (US 6,366,359) and Ito et al (6,529,522).

Claim 3: Garland discloses a printer as claimed, except Garland does not explicitly say that the printer includes a converting means. However, printer that includes converting means is a very well known procedure in the art in order to convert video data into data format suitable for printing (as evidence see for instance Ito at Fig. 3 items 202, 312); thus, an artisan would be motivated to combine the references to arrive at the claimed invention. Therefore, the claimed invention would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 4, 5 are disclosed, see Ito at Fig. 3 item 202, 313.

Claims 14-16 are rejected for the same reasons as claims 3-5.

Claims 31-33 are rejected for the same reasons as claims 3-5.

Claims 41-43 are rejected for the same reasons as claims 3-5.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the limitation "said first signal transmission means" in line 6; there is no antecedent basis for this limitation in the claim.

Allowable Subject Matter

7. Claims 10, 11, 21, 22, 37, 38, 48, 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments have been fully considered but they are moot in view of new interpretation of the references necessitated by the amendment and the new ground of rejection under 35 USC 112 necessitated by the amendment.

Conclusion

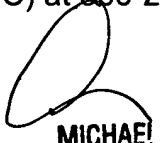
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean W. Désir whose telephone number is (703) 308 9571. The examiner can normally be reached on 5/4/9 - First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (703) 305 4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
Mar. 21, 04



MICHAEL H. LEE
PRIMARY EXAM. EP